

REMARKS

This is a reply to the Final Rejection of the pending claims in the Office Action of January 20, 2006.

Claims 1 through 20 are currently pending in the application.

Claim 16 has been amended herein. Support for the amendment may be found throughout the specification and particularly in paragraphs [0005] through [0009]. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendment is to clearly distinguish the claimed invention over the cited art. The amendment is made without prejudice or disclaimer.

Applicant respectfully requests reconsideration of the rejections.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Takaira *et al.* (U.S. Patent 6,750,982)

Claims 1 through 10 and 16 through 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takaira *et al.* (U.S. Patent 6,750,982) (hereinafter "Takaira"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure.

Applicant further asserts that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Applicant additionally asserts that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

Claim 1 recites a method of distributing data from an e-mail enabled printer, the method comprising . . . retrieving an at least one print job data file from a memory of the e-mail enabled printer, attaching the at least one print job data file to an e-mail, sending the e-mail and attached at least one print job data file to an e-mail enabled device, and storing at least the attached at least one print job data file in a job retention memory of the e-mail enabled device.

Applicant asserts that Takaira does not teach or suggest all of the claim limitations of independent claim 1 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Takaira does not teach or suggest the claim limitation of the claimed invention calling for “attaching said at least one print job data file to an e-mail.” It was acknowledged by the Office that “Takaira does not disclose expressly that the attached file is a print job data file.” *Final Office Action mailed January 20, 2006, p. 3*. It was asserted that “it is well-known in the art that an email attachment file can be printed therefore making the file a print job data file.” *Id.*

Applicant asserts that Takaira teaches attaching printer driver software to electronic mail. *Col. 4, lines 18-20*. Applicant asserts that the Examiner’s argument is not applicable to Takaira. Applicant asserts that the printer driver software would not be sent in a printable format, because the attachment of Takaira is installed. *Col. 4, lines 33-35*. The printer driver software of Takaira is likely sent as an executable file. Applicant asserts that because the attachment of Takaira is not even printable, then the Examiner’s reasoning is not applicable to Takaira. It should be noted that claim 1 does not require the printability of the “print job data file” by a receiver, but rather, for the Examiner’s argument to even apply to Takaira, the printer driver software attachment must be printable. Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, independent claim 1 is allowable.

Applicant further asserts that there is no suggestion or motivation to modify Takaira to teach “attaching said at least one print job data file to an e-mail.” Applicant asserts that Takaira teaches the attachment of printer driver software to “reduce burdensome installing operation to be performed by the supervisor.” If that software is replaced with a print job data file, then the printers of Takaira will no longer be able to perform the installation of printer driver software. Applicant asserts that such a proposed modification destroys the intended

purpose of the invention of Takaira. Therefore, there can be no suggestion or motivation to modify Takaira to teach a print job data file.

Applicant additionally asserts that the proposed modification would change a principle of operation of Takaira, namely, the function of performing printer driver software installation. Therefore, there can be no suggestion or motivation to modify Takaira to teach a print job data file.

Applicant asserts that the proposed modification may only have been suggested by the Applicant's application. Therefore, the proposed modification must impermissibly be based upon hindsight.

Therefore, for at least the above reasons, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because there is not and cannot be any suggestion or motivation to modify the claimed invention. Accordingly, independent claim 1 is allowable.

Additionally, Applicant asserts that the Examiner is essentially relying upon an "official notice" of facts to modify the claimed invention. Applicant notes that "official notice" should rarely be relied upon when an application is under final rejection. *M.P.E.P.* § 2144.03, A.

Claims 1 through 10 are allowable for at least the reason of depending from allowable independent claim 1.

Presently amended independent claim 16 recites a system for distributing data, comprising . . . a network, and at least one e-mail enabled printer for communicating over the network, the e-mail enabled printer comprising at least one microprocessor for operating the e-mail enabled printer, the at least one microprocessor is capable of attaching print jobs to e-mails, a display panel for displaying the print jobs and related data, and a job retention memory for storing the print jobs and the related data for distribution.

Applicant asserts that Takaira does not teach or suggest all of the claim limitations of presently amended independent claim 16 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that Takaira does not teach or suggest the claim limitation of the claimed invention calling for "said e-mail enabled printer comprising . . . a display panel for displaying said print jobs and related data." It was asserted by the Office that operational panel unit 18 of Takaira teaches the above limitation. *Final Office Action mailed January 20, 2006, pp. 5-6.* However, operational panel unit 18 is limited to input functions. *See, e.g., Col. 4, lines 1-2.* Applicant asserts that

Takaira does not teach a printer comprising a display panel. Additionally, Applicant asserts that Takaira does not teach or suggest the claim limitation of the claimed invention calling for “said at least one microprocessor is capable of attaching print jobs to e-mails.” Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, presently amended independent claim 16 is allowable.

Claims 17 through 20 are allowable for at least the reason of depending from allowable presently amended independent claim 16.

Obviousness Rejection Based on Takaira in View of Kageyama *et al.* (U.S. Patent 6,567, 180)

Claims 11 through 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Takaira in view of Kageyama *et al.* (U.S. Patent 6,567,180) (hereinafter “Kageyama”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Claim 11 recites a method of distributing a print job, comprising . . . storing one or more print jobs in a memory of an e-mail enabled printer, selecting at least one of the one or more print jobs stored in the memory of the e-mail enabled printer for distribution, creating an e-mail, attaching the selected at least one print job to the e-mail, and sending the e-mail for distributing the selected at least one print jobs.

Applicant asserts that Takaira and Kageyama, even if combined, do not teach or suggest all of the claim limitations of independent claim 11 to establish a *prima facie* case of obviousness regarding the claimed invention under 35 U.S.C. § 103. Applicant asserts that neither Takaira nor Kageyama teach or suggest the claim limitation of the claimed invention calling for “attaching said selected at least one print job to said e-mail.” Therefore, for at least this reason, a *prima facie* case of obviousness under 35 U.S.C. § 103 has not been established because any combination of the cited art cannot and does not teach or suggest all the claim limitations of the claimed invention. Accordingly, independent claim 11 is allowable.

Claims 11 through 15 are allowable for at least the reason of depending from allowable independent claim 11.

Applicant submits that claims 1 through 20 are clearly allowable over the cited art.

Applicants request entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment does not require any further search or consideration.

The amendment places the application in condition for allowance.

Respectfully submitted,



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